

IN THE UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

ROBERT TRENT JONES II, INC. and
ROBERT TRENT JONES LICENSING
GROUP, LLC

Plaintiffs,

v.

GFSI, INC. d/b/a GEAR FOR SPORTS,
INC.

Defendants.

Case No. 07-CV-04913-EDL

**[Proposed]
ORDER FOR PRELIMINARY
INJUNCTION**

Magistrate Judge Elizabeth D. Laporte



Plaintiffs, Robert Trent Jones II, Inc. and Robert Trent Jones Licensing Group, LLC (hereinafter "Plaintiffs"), duly commenced this action by filing the Complaint herein against defendant, GFSI, INC. d/b/a GEAR FOR SPORTS, INC. (hereinafter "Defendant") alleging breach of contract, willful federal trademark infringement, unfair competition and dilution. Plaintiffs filed a Motion for Preliminary Injunction and supporting memorandum and declarations. Defendants filed opposition to plaintiff's motion. Having considered the Complaint, the aforementioned motion and supporting and opposing memoranda and declarations, it is hereby ORDERED, ADJUDGED AND DECREED that:

1. This Court has jurisdiction over the parties and the subject matter as set forth in the Complaint in this action.

2. The evidence presented in support of Plaintiffs' Motion establishes that on May 1, 2005, Plaintiff Robert Trent Jones II, Inc. and Defendant entered into an Intellectual Property License Agreement ("License Agreement") which licenses to Defendant on an exclusive basis

specific intellectual property (“Licensed Rights”) for use in connection with golf apparel (“Licensed Products”). The Licensed Rights include the following:

United States Trademark Registrations

Mark	Reg. No.	Status	Reg. Date	Goods
ROBERT TRENT JONES	1,899,912	Incontestable	06/13/95	Men's accessories, namely jackets, shirts, pants, shorts, sweaters
	3,205,541	Registered	02/06/07	Clothing, namely shirts, sweaters, sweater vests, trousers, shorts, jackets, headwear
	3,128,905	Registered	08/15/06	Pants, shorts, sweaters, jackets, sweatshirts, vests, long-sleeved and short-sleeved golf shirts

Rights of Publicity

The Robert Trent Jones, Jr. Name
The Robert Trent Jones, Jr. Signature
Likeness, Image and Persona of Robert Trent Jones, Jr.

3. The evidence presented in support of Plaintiffs’ Motion establishes that the License Agreement prohibits Defendant from selling Licensed Products to discount stores, with the exception that Defendant may sell damaged, defective, seconds, or otherwise substandard Licensed Products to Secondary Markets, a specific type of discount store, provided that Defendant removes all Licensed Rights identification from the apparel prior to sales, display or distribution.

4. The evidence presented in support of Plaintiffs’ Motion establishes that without Plaintiffs’ authorization, Defendant has sold, and is selling, Licensed Products to discount stores, including Secondary Markets, with Licensed Rights still intact.

1 5. The evidence presented in support of Plaintiffs' Motion establishes that without
2 Plaintiffs' authorization, Defendant also has sold, and is selling, damaged, defective, seconds, or
3 otherwise substandard Licensed Products to Secondary Markets with the Licensed Rights still
4 intact.

5 6. This Court finds that Plaintiffs have shown a probable success on the merits and
6 the possibility of irreparable injury if Defendant is not enjoined from sales of Licensed Products
7 to discount stores. Specifically, Defendant's unauthorized use of the Licensed Rights stemming
8 from Defendant's breach of the License Agreement is likely to cause confusion, or to cause
9 mistake, or to deceive, and constitutes, among other things: federal trademark infringement in
10 violation of Section 32(1) of the Lanham Act, 15 U.S.C. § 1114(1); federal unfair competition in
11 violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a); federal trademark dilution in
12 violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c); state unfair competition in
13 violation of the California Business and Professions Code, § 17200, et seq., and the common
14 laws of California; and state trademark dilution in violation of the California Business and
15 Professions Code, § 14330, et seq., and the common laws of California.

16 7. Defendant, any business entity owned or controlled by Defendant, and their
17 officers, directors, shareholders, agents, servants, employees, subcontractors, partners, licensees,
18 subsidiaries, affiliates and related companies or entities, representatives, attorneys and other
19 persons or entities acting in concert or participation with any of them, are enjoined and restrained
20 from:
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- 23 a. selling or distributing any Licensed Product other than damaged, defective,
24 seconds or product that is otherwise substandard, to any discount store
25 (encompassing any retail seller that generally offers, sells or advertises

1 product at prices reduced or discounted from those prices generally offered,
2 advertised or sold at by full-price retail sellers), regardless of whether such
3 discount store is a Secondary Market, as that term is defined in the License
4 Agreement;

- 5 b. selling, displaying or distributing any damaged, defective, seconds, or
6 otherwise substandard product to any reseller, with the sole exception that
7 such damaged, defective, seconds or otherwise substandard product may be
8 sold or distributed to Secondary Markets, as that term is defined under the
9 License Agreement, so long as the Licensed Rights are first (that is, prior to
10 sale to such Secondary Markets) removed from said product.
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12 until this action is resolved or final judgment is entered by the Court.

13 8. Within three (3) days of this Order, Defendant shall provide a copy of this order to
14 all discount stores to which Defendant has sold Licensed Products and issue a “stop sale
15 request,” requesting that the discount stores comply with this order and cease all sales of
16 Licensed Products until this action is resolved or final judgment is entered by the Court.

17 9. Defendant acknowledges that a violation of any provision of this Preliminary
18 Injunction will be a willful and knowing violation of Plaintiffs’ rights causing serious and
19 substantial, irreparable damage to Plaintiffs, and that it will be difficult, if not impossible, to
20 determine the amount and extent of such damage. If Defendant violates any term or condition of
21 this Preliminary Injunction, Plaintiffs shall immediately be entitled to a judgment finding that
22 Defendant is in contempt, to an award of reasonable damages and attorney’s fees, and to such
23 further relief the Court deems appropriate.
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1 10. This Court shall retain jurisdiction over the parties and the subject matter of this
2 action for purposes of enforcing this Preliminary Injunction entered herein.
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6 Date: _____ Entered: _____
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8 Judge _____
9 United States District Court
10 Northern District of California
11 San Francisco Division
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